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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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SU, EMILE

ART UNIT	PAPER NUMBER
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3685

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/549,293	<b>Applicant(s)</b> EBIHARA ET AL.	
	<b>Examiner</b> EMILE SU	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-10 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office Action is in response to communications filed on April 5, 2010. Claims 1, 8, 12 are amended. Claims 4 and 11 are cancelled.
2. Claims 1-3, 5-10, and 12 are currently presented for examination and are rejected.

### ***Response to Arguments***

3. Applicant's arguments filed April 5, 2010 have been fully considered.

Applicant is of the first opinion that Claim 8 has met U.S.C. §101 requirements (Remarks, p. 8). Examiner respectfully disagrees. Specifically, Applicant argues that “the steps of ‘transmitting’ and ‘reproducing’ do not need to be tied to another statutory class ..., §101 only requires that the method be tied to a particular apparatus” (Remarks, p. 8), which implies that these two steps are not part of the claimed method. Given Applicant’s position that only the method needs to be tied and particularly excluding these two steps to be tied, Examiner logically concludes that the two steps are not regarded by the Applicant to be part of the claimed method. These two steps will be understood as not given patentable weight with reference to prior art. However, Applicant is silent as to the step of “using unique key information to encrypt ...” pointed out in the previous Office Action. Examiner maintains the position in the previous Office Action that method step of “using” still lacks a tie to another machine. The rejection under U.S.C. §101 is maintained.

Applicant is of the second opinion that second execution file can be stored on a medium or external to the medium (Remarks, p. 8). Upon further consideration of Applicant’s reasoning that claim limitations are merely broad, Examiner withdraws the previous U.S.C. §112 second paragraph rejection. However, Applicant is reminded that the limitations “said second execution file generates ...” in Claim 1 are given no patentable weight as the limitations are reciting features not included on the claimed computer-storage medium.

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Applicant is of the third opinion that it is clear encryption key information is used for encrypting digital signature information (Remarks, p. 9). Examiner respectfully disagrees. Specifically, Applicant's recited limitation of "unique key information is configured to encrypt encryption key information which is used for encrypting digital signature information" is ambiguous whether the term "which" is referring to the object of "encryption key information" or the "encrypt[ed] encryption key information" in the sentence. Applicant's arguments are not found persuasive.

Applicant is of the fourth opinion that prior art of Rodgers does not teach novel features of Claims 1-3, 5-7, and 12 (Remarks, p. 9-12). Examiner respectfully disagrees. Specifically, Claims 1-3, 5-7, and 12 are all directed to an apparatus. Claims 1 and 12 are representing simply a computer-storage medium apparatus, and Claim 5 is representing an information processing apparatus. Applicant is reminded that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP §2114; *In re Swineheart*, 169 USPQ 226, 228-29 (CCPA 1971); *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). In terms of structure, Claims 1 and 12 are merely directed to a computer-storage medium. What is recorded on the structure does not alter the structure to differentiate from the prior art. As to Claim 5, the only positively recited structure consists of the processor. This is because a file is merely printed data on the structure. While Claims 1-3, 5-7, and 12 recite features, none of the features are recited in a manner that will alternate the hardware utilized by the invention. Therefore, the non-structure elements of the claims have been considered but are given little patentable weight that will not separate the claimed invention from the prior art. The cited reference of Rodgers continues to read on the claimed invention.

Applicant is reminded that as a mere example, an acceptable form to claim data structures would be "a non-transitory computer-readable medium having computer-readable coded stored thereon, and when the computer-readable code is executed by a computer processor, the computer-readable code causes the computer processor to calculate data".

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Applicant is of the fifth opinion that the cited references do not teach limitation of the amended claims (Remarks, p. 15). Examiner respectfully disagrees. Specifically, Nakano'222 discloses transmitting unique key information to a first file (see Nakano'222, ¶100-101; also see ¶76). Therefore, the cited references continue to read on the claimed invention.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1, 8, and 12** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Concerning Claims 1 and 12**, data structures not claimed as embodied in computer-readable medium are software per se and are not statutory because they are not capable of causing functional change in the computer. *See In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held non-statutory). Such claimed data structures are merely abstract ideas that do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. *See In re Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

While Claims 1 and 12 include a computer-readable medium, the claimed invention taken as a whole is directed to a mere storage of data. The claim still lacks necessary language that realizes the computer program's functionality. Specifically, the claims are lacking the execution of a computer program and an interrelationship between the computer program and a device for performing a function.

As mere example, an acceptable form to claim data structures would be "a non-transitory computer-readable medium having computer-readable coded stored thereon, and when the computer-readable code is executed by a computer processor, the computer-readable code causes the computer processor to calculate data".

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**Concerning Claim 8**, Applicant's method claim is non-statutory for failing the machine-or-transformation test. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, in order for a method to be considered a "process" under 35 U.S.C. §101, a claimed process must either: (1) be tied to another machine or apparatus (machine implemented) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the machine to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, Claim 8 fails prong (1) because the step of "using unique key information to encrypt ..." is not tied to another machine. Additionally, the claim fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

**As to Claims 2-3**, see discussion of Claim 1 above. These depending claims inherit and repeat the same U.S.C. §101 deficiency as Claim 1 and are rejected in the like manner above.

**As to Claims 9-10**, see discussion of Claim 8 above. These depending claims inherit and repeat the same U.S.C. §101 deficiency as Claim 8 and are rejected in the like manner above.

***Claim Rejections - 35 USC § 112, Second Paragraph***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-3, 5-10, and 12** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**(a) Ambiguous Product and Process Claims**

Regarding Claim 1, Applicant's recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims a "computer-readable storage medium" while also claiming a process of using the component "wherein the instructions ... are executed ... when said computer-readable storage medium is inserted into said information processing apparatus". A single claim which purports to be both a product or machine and a process is ambiguous and is rejected for failing to particularly point out and distinctly claim the invention. See *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

**Regarding Claim 5**, Applicant's recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims a "a second execution file" while also claiming a process of using the component "said second execution file is executed when said compute-readable storage medium is inserted into the information processing apparatus". A single claim which purports to be both a product or machine and a process is ambiguous and is rejected for failing to particularly point out and distinctly claim the invention.

**Regarding Claim 12**, Applicant's recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims a "a first execution file" while also claiming a process of using the component "executed, by an information processing apparatus including a processor, when the compute-readable storage medium is inserted into the information processing apparatus". A single claim which purports to be both a product or machine and a process is ambiguous and is rejected for failing to particularly point out and distinctly claim the invention.

**(b) Unclear Claim Language**

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**Regarding Claims 1 and 5**, Applicant recites “said unique key information is configured to encrypt encryption key information which is used for encryption digital signature information” in the limitations. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether “encryption key information is used for encryption digital signature information” or “by encrypting encryption key information, it can then be used for encrypting digital signature information” (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

**Regarding Claims 1 and 5**, Applicant amended to recite “digital signature information that has previously been attached to said encrypted content” in the limitation. The claim language, however, is unclear to one of ordinary skill in the art as it does not explicitly point out whether “previously been attached” is merely describing the signature or an actual step that needs to be performed. This renders the claim to be unclear.

**Regarding Claims 7 and 8**, Applicant recites “unique key information ... to encrypt encryption key information for encrypting digital signature information” in the limitations. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether “encryption key information is for encryption digital signature information” or “by encrypting encryption key information, it can then be for encrypting digital signature information”.

**Regarding Claim 8**, Applicant recites “reproducing the decrypted content with the information processing apparatus” at line 13 of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether reproducing is done by the apparatus or some other entity is reproducing content that comes along with the apparatus.

**Regarding Claim 12**, Applicant recites “to verify digital authentication information attached to a content downloaded via network by using unique key information” at line 6 of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether verifying uses unique key information or downloading uses unique key information.

**(c) Depending Claims**



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**As to Claims 2-3**, see discussion of Claim 1 above. These depending claims inherit the same U.S.C. §112 second paragraph deficiencies as Claim 1 and are rejected in the like manner above.

**As to Claim 6**, see discussion of Claim 5 above. This depending claim inherits the same U.S.C. §112 second paragraph deficiencies as Claim 5 and is rejected in the like manner above.

**As to Claims 9-10**, see discussion of Claim 8 above. These depending claims inherit the same U.S.C. §112 second paragraph deficiencies as Claim 8 and are rejected in the like manner above.

#### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-3, 5-7, and 12** are rejected under 35 U.S.C. 102(b) as being anticipated by Rodgers et al., U.S. Patent Application Publication No. 2002/0026478 A1 (hereinafter Rodgers).

**With respect to Claims 1-3 and 12**, Rodgers discloses a computer-readable medium comprising program code (see Rodgers, ¶170).

**With respect to Claims 5-7**, Rodgers discloses an information processing apparatus comprising a processor (see Rodgers, ¶169) and program code (see Rodgers, ¶170).

#### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. **Claims 1-3, 5-10, and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al., U.S. Patent Application Publication No. 2003/0152222 A1 (hereinafter Nakano'222) in view of Danneels et al., U.S. Patent No. 6,272,472 B1 (hereinafter Danneels), Nakano et al., U.S. Patent Application Publication No. 2004/0243814 (hereinafter Nakano'814), and Matsuyama et al., U.S. Patent Application Publication No. 2002/0026581 A1 (hereinafter Matsuyama).

**With respect to Claims 1, 5, 8, and 12**, Nakano'222 discloses:

a first execution cause an information processing apparatus (see Nakano'222, ¶43) to perform an authentication process with a second execution (see Nakano'222, ¶95-100; also see ¶61-65);

cause an information processing apparatus (see Nakano'222, ¶43) to obtain unique key information unique to said first execution (see Nakano'222, ¶100; also see ¶45-46, ¶61, ¶76, and ¶88); and

cause an information processing apparatus (see Nakano'222, ¶43) to transmit said unique key information to said second execution (see Nakano'222, ¶100-101; also see ¶76);

wherein the first execution is executed by an information processing apparatus (see Nakano'222, ¶76; also see ¶7 and ¶95), and said second execution generates a content key from said transmitted unique key information, decrypts encrypted content that is recorded on said computer-readable storage medium (see Nakano'222, ¶101; also see ¶10 and ¶15) using the content key, and reproduces the decrypted content (see Nakano'222, ¶100-102; also see ¶70-72); and

wherein said encrypted content is recorded on said computer-readable storage medium (see Nakano'222, ¶48) and said unique key information is configured to encrypt encryption key information (see Nakano'222, ¶58; also see ¶84-89) which is used for a digital signature attached to said encrypted content (see Nakano'222, ¶92-93; also see ¶61-65), and said instructions for transmitting cause said encrypted content to be transmitted to said second execution (see Nakano'222, ¶101; also see ¶15 and ¶71) based on said digital signature information (see Nakano'222, ¶100; also see ¶73).

Nakano'222 does not specifically disclose instructions executable by an information processing apparatus stored on a medium. Danneels does teach a computer-implemented method realized as one or more programs executable on a computer (see Danneels, col. 2, lines 40-46). In addition, Danneels teaches that the programs are storable on a computer-readable medium such as a floppy disk or a CD-ROM (see Danneels, col. 2, lines 46-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Nakano'222 discussed in Claim 1. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of distribution and installation and execution of the software on another computer (see Danneels, col. 3, lines 46-49).

Nakano'222 does not specifically disclose an execution file, an apparatus including a processor, and inserting a medium into said apparatus. However, Nakano'222 does disclose medium connecting to the apparatus as prior art (see Nakano'222, ¶13) and Nakano'814 does teach an execution file (see Nakano'814, ¶664; also see ¶669), an apparatus including a processor (see Nakano'814, ¶201), and when a medium is inserted into said apparatus (see Nakano'814, ¶447-448). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a processor in the apparatus because it quickly performs dynamic calculations. It would have been obvious to one of ordinary skill in the art at the time of the invention to react at the time of inserting a medium into an apparatus, because automation in executing a file reduces system idle time.

Nakano'222 does not specifically disclose encrypting digital signature. Matsuyama does teach encrypting digital signature information (see Matsuyama, ¶169). It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt digital signature because encryption increasing security of communication.

Further, Applicant is reminded that it has been held stored data is not functionally related to the memory in which it is stored and does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983); *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The non-functional limitations "instructions for performing an

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authentication ... instructions for obtaining ... instructions for transmitting ... to said second execution file” in Claim 1 are not given patentable weight. The non-functional limitation “comprising: a first execution file ... is inserted into the information processing apparatus” in Claim 12 is not given patentable weight.

Further, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP §2114; *In re Swineheart*, 169 USPQ 226, 228-29 (CCPA 1971); *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). The limitations following “a processor ...” in Claim 5 are not given patentable weight.

Further, it has been held that language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C). The intended use language “to encrypt encryption key information which is used for encrypting digital signature” and “cause said encrypted content to be transmitted” of Claims 1 and 5 are not given patentable weight. The intended use language “using unique key information to encrypt” in Claim 8 is not given patentable weight. The limitation following “configured to ...” in Claims 1, 5, and 12 are not given patentable weight.

**As to Claim 2**, Nakano’222, Danneels, Nakano’814, and Matsuyama disclose the invention substantially as claimed. Nakano’222 further discloses unique key information is used to encrypt encryption key information for encrypting a content (see Nakano’222, see Nakano’222, ¶58; also see ¶84-89).

Further, the limitation “said unique key information is used to encrypt encryption key information for encrypting a content” merely present the intended use of unique key information. It has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP §2106 II C). This limitation is not given patentable weight.

**As to Claim 3 and 6**, Nakano’222, Danneels, Nakano’814, and Matsuyama disclose the invention substantially as claimed. Nakano’222 further discloses said

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encrypted content is recorded on said computer-readable storage medium (see Nakano'222, ¶47; also see Fig. 1).

Further, it has been held that a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C). The limitations in Claims 3 and 6 are not given patentable weight.

Further, it has been held that stored data is not functionally related to the memory in which it is stored it does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The limitations of Claims 3 and 6 are not given patentable weight.

**As to Claim 7**, Nakano'222, Danneels, Nakano'814, and Matsuyama disclose the invention substantially as claimed. Nakano'222 further discloses encrypted content is recorded on said computer-readable storage medium (see Nakano'222, ¶47; also see Fig. 1) and second execution file can receive said encrypted content from said first execution file (see Nakano'222, ¶101; also see ¶15 and ¶71) based on said digital signature information (see Nakano'222, ¶100; also see ¶73).

Further, it has been held that a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C). The limitations of Claim 7 are not given patentable weight.

Further, it has been held that stored data is not functionally related to the memory in which it is stored it does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The

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limitations “encrypted content is recorded on said computer-readable storage medium” is not given patentable weight.

Further, it has been held language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C). The intended use language “unique key information is used to encrypt ...” is not given patentable weight. The optional language of “second execution file can receive” is not given patentable weight.

**As to Claim 9**, Nakano’222, Danneels, Nakano’814, and Matsuyama disclose the invention substantially as claimed. Nakano’222 further discloses encrypted content is recorded in information processing apparatus (see Nakano’222, ¶101; also see ¶15).

Further, it has been held that a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C). The amended limitations of Claim 9 are not given patentable weight.

Further, it has been held that stored data is not functionally related to the memory in which it is stored it does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The limitation of Claim 9 is not given patentable weight.

**As to Claim 10**, Nakano’222, Danneels, Nakano’814, and Matsuyama disclose the invention substantially as claimed. Nakano’222 further discloses encrypted content stored in a different information processing apparatus (see Nakano’222, ¶59; also see ¶89).

Further, it has been held that a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim ((*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v.*

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*Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001); MPEP §2106 II C). The amended limitations of Claim 10 are not given patentable weight.

Further, it has been held that stored data is not functionally related to the memory in which it is stored it does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). The limitation of Claim 10 is not given patentable weight.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571) 270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CALVIN L. HEWITT can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3685

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILE SU/  
Examiner, Art Unit 3685  
July 2, 2010

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685